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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,311	06/25/2003	Binnur Ozturk	204.001	5252

30332 7590 01/12/2006

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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/603,311	<b>Applicant(s)</b> OZTURK ET AL.	
	<b>Examiner</b> Marina Lamm	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 10-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 65-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/27/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group I, Claims 1-9 and 65-67 in the reply filed on 10/12/05 is acknowledged.
2. Claims pending are 1-67. Claims 10-64 have been withdrawn from further consideration as directed to non-elected invention. Claims 1-9 and 65-67 are being examined on the merits.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 contains the trademark/trade name "pentravan". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the

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present case, the trademark/trade name is used to identify/describe some type of emollient base and, accordingly, the identification/description is indefinite. *Further, it is unclear what exactly is meant by "pentravan", since the specification does not describe the contents of the gel, thus, rendering the search impossible.*

Claim 3 contains the trademark/trade names "pleurinic" and "lipoil". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe some type of emollient base and, accordingly, the identification/description is indefinite. *Further, it is unclear what exactly is meant by "pleurinic" since the specification does not describe the contents of the gel, thus, rendering the search impossible.*

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-9 and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolicki (US 2004/0101582) in view of either Williams et al. (US 2003/0082214) or Murdock et al. (US 6,572,880), both supplied by the Applicant.

Wolicki teaches transdermal compositions for the treatment of neuropathy comprising 10-50%, preferably 15-20% of ketamine, 0.001-2%, preferably 0.1-1%, of clonidine, 1-10%, preferably 2-5% of amitriptyline, and 1-30%, preferably 3% or 6% of gabapentin. See Abstract; p. 2, [0017]-[0021]; p. 4, [0040]-[0042], [0047]; p. 8, [0089]. The carriers include cream, ointment or gel carriers. See p. 3, [0023]; p. 7, [0076]-[0078]; p. 10, [0105]. The compositions of Wolicki may additionally contain penetration enhancers. See p. 2, [0018]. The compositions are useful for relieving pain, inflammation and irritation associated with skin diseases and disorders. See p. 7, [0074]. Wolicki does not teach the claimed anti-inflammatory component. However, Williams et al. teach using non-steroidal anti-inflammatory analgesics such as acetylsalicylic acid, ketoprofen, indomethacin, etc. in transdermal compositions for treating pain. See Abstract; p. 10, [0151]. Similarly, Murdock et al. teach ketoprofen in combination with gabapentin and/or amitriptyline in transdermal compositions for pain relief. See Abstract; col. 8, lines 55-65; Examples 53-55, 63; col. 34, col. 39-40. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Wolicki such that to use an anti-inflammatory agent such as ketoprofen. One having ordinary skill in the

art would have been motivated to do this to obtain an additional pain relieving effect as suggested by either Williams et al. or Murdock et al.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,164,416; US 6,010,716; US 6,518,311; US 6,730,667; <http://www.gallipot.com/ui/Base.aspx>.

8. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Sreenivasan Padmanabhan, can be reached at (571) 272-0629.

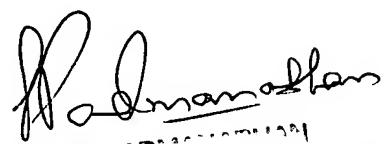
The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Lamm  
1/6/06

A handwritten signature in black ink, appearing to be 'Marina Lamm', written over the printed name and date.A handwritten signature in black ink, appearing to be 'Sreeni Padmanabhan', written over the printed name and title.

SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER